

Attorney Docket No.: ISPH-0463
Inventors: Monia et al.
Serial No.: 09/575,554
Filing Date: May 22, 2000
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REMARKS

Claims 1 and 7-20 are pending in the instant application. Claims 1 and 7-10 have been rejected. Claims 1 and 11-13 have been amended. Reconsideration is respectfully requested in light of the following remarks.

I. Status

Applicants acknowledge that the decision of the Board of Patent Appeals and Interferences has found that claims drawn to oligonucleotides other than SEQ ID NO's 26 and 28 are allowable.

II. Rejection of Claims Under 35 U.S.C. 102(e)

Claims 1 and 10 have been rejected under 35 U.S.C. 102(e) as being anticipated by Bos et al. (US Patent 5,591,582). The Examiner suggests that this patent discloses an oligonucleotide which is identical to SEQ ID NO: 26 except that it is shorter by one base at the 5' end while another oligomer taught in this patent is identical to SEQ ID NO: 28 except that it is shorter by one base at the 5' end. The Examiner also suggests that this patent teaches administration of oligonucleotides in a pharmaceutically acceptable carrier. Applicants respectfully traverse this rejection.

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Applicants have amended claim 1 to remove recitation of SEQ ID NO's 26 and 28. As acknowledged by the Examiner, this patent fails to teach any other antisense oligonucleotides and further that without these sequences listed the claims are allowable. In order to anticipate an invention the cited reference must teach each and every limitation of the claims (MPEP 2131). Accordingly, the claims as amended are not anticipated by the cited reference. Withdrawal of this rejection is respectfully requested.

III. Rejection of Claims Under 35 U.S.C. 103(a)

Claims 7 and 9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Bos et al. (US Patent 5,591,582), in view of Ott et al. (1987). The Examiner suggests that it would have been *prima facie* obvious for one of ordinary skill in the art to modify the oligonucleotides of Bos et al. with the modifications taught by Ott et al. Applicants respectfully traverse this rejection.

As discussed *supra*, Applicants have amended the base claim to refer to sequences other than SEQ ID NO's 26 and 28. The primary reference of Bos et al. discloses only two sequences that share homology to two sequences cited in claim 1, SEQ ID NO's 26 and 28.

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No other sequences of the instant invention are taught in this reference, nor are any antisense compounds specifically targeted to Ki-ras. The secondary reference of Ott et al. (1987) teaches modification of primers for mutagenesis. Nowhere does this paper teach or suggest antisense compounds of any type targeted to Ki-ras, as claimed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art must teach or suggest all claim limitations. Clearly, the combination of prior art cited fails to teach or suggest the limitations of the claims as amended, which claim specific antisense oligonucleotide sequences, other than SEQ ID NO's 26 and 28, that are targeted to human Ki-ras, and thus cannot render the instant claimed invention obvious. Withdrawal of this rejection is therefore respectfully requested.

Claim 8 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Bos et al., in view of Manoharan et al. (1991).

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The Examiner suggests it would have been *prima facie* obvious for one of ordinary skill to modify the oligonucleotides of Bos et al. with the 2' labeling of Manoharan et al.. Applicants respectfully traverse this rejection.

As discussed *supra*, Applicants have amended the base claim to refer to sequences other than SEQ ID NO's 26 and 28. The primary reference of Bos et al. discloses only two sequences that share homology to two sequences cited in claim 1, SEQ ID NO's 26 and 28. No other sequences of the instant invention are taught in this reference, nor are any antisense compounds specifically targeted to Ki-ras. The secondary reference of Manoharan et al. (1991) teaches modification of nucleic acid molecules. Nowhere does this paper teach or suggest antisense compounds of any type targeted to Ki-ras, as claimed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art must teach or suggest all claim limitations.

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Clearly, the combination of prior art cited fails to teach or suggest the limitations of the claims as amended, which claim specific antisense oligonucleotide sequences, other than SEQ ID NO's 26 and 28, that are targeted to human Ki-ras, and thus cannot render the instant claimed invention obvious. Withdrawal of this rejection is therefore respectfully requested.

IV. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

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